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PATENT APPLICATION

ATTORNEY DOCKET NO. 10016469-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICEInventor(s): Jeffrey G. WileyConfirmation No.: 8739Application No.: 10/033,225Examiner: EHICHIOYA, Fred I.Filing Date: 10-28-2001Group Art Unit: 2162Title: Data Access Methods and Multifunction Device ThereforMail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 11-15-2005

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300.Date of facsimile: December 16, 2005Typed Name: Mark D. TrennerSignature: Mark D. Trenner

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 10/033,225
Filing Date October 25, 2001
Inventorship..... Jeffrey G. Wiley
Applicant/Appellant..... Hewlett-Packard Company
Group Art Unit 2162
Examiner Ehichioya, Fred I.
Confirmation No. 8739
Attorney's Docket No. 10016469-1
Title: Data Access Methods and Multifunction Device Therefor

APPEAL BRIEF

To: MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under 37 C.F.R. §41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on November 15, 2005, and is in furtherance to the Notice of Appeal.

This brief contains items under the following headings as required by 37 C.F.R. §41.37 and M.P.E.P. §1206:

- I. Real Party In Interest
- II. Related Appeals, Interferences, and Judicial Proceedings
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix | 12/19/2005 BABRAHA1 00000017 082025 10033225
- IX. Evidence Appendix | 01 FC:1402 500.00 DA
- X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 24 claims pending in this application (Claims 1, 4-12, and 14-27).

B. Current Status of Claims

1. Claims canceled: 2, 3, and 13
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1, 4-12, and 14-27
4. Claims allowed: None
5. Claims rejected: 1, 4-12, and 14-27

C. Claims on Appeal

The claims on appeal are claims 1, 4-12, and 14-27.

IV. STATUS OF AMENDMENTS

Appellant last amended the claims in an Amendment and Response filed on April 21, 2005. Although Appellant filed a Response After Final Action, dated October 7, 2005, Appellant did not amend any claims in this Response. Therefore the claims on appeal (as reflected in the claim appendix) are the claims presented in the Amendment and Response filed on April 21, 2005 and previously entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

According to claim 1, a method for providing access from a multifunction device (100 in FIG. 1; p. 5, ll. 25-30) to an electronic document (120 in FIG. 1; p. 6, ll. 5-15) at a user-specified remote storage device (150 in FIG. 1; p. 6, ll. 13-15). The method comprising identifying (500 in FIG. 4; p. 17, ll. 12-15) said user-specified remote storage device (150 in FIG. 1) having said electronic document (120 in FIG. 1) based at least in part on a path (310 in FIG. 3; p. 14, ll. 26-33) thereto specified by a user at said multifunction device (100 in FIG. 1). The method also comprising establishing (510 in FIG. 4; p. 17, ll. 15-20) a link between said multifunction device (100 in FIG. 1) and a user-specified remote storage device (150 in FIG. 1) having said electronic document (120 in FIG. 1). The method also comprising accessing (520 in FIG. 4; p. 17, ll. 20-22) said electronic document (120 in FIG. 1) at said user-specified remote storage device (150 in FIG. 1) from said multifunction device (100 in FIG. 1) over said link established therebetween. The method also comprising sending said electronic document (120 in FIG. 1) from said multifunction device (100 in FIG. 1).

According to claim 12, a method for accessing user-requested data from a configured multifunction device (100 in FIG. 1; p. 5, ll. 25-30). The method comprising identifying a remote storage device (150 in FIG. 1; p. 6, ll. 13-15) having a user-requested document (120 in FIG. 1; p. 6, ll. 5-15) based at least

in part on a path (310 in FIG. 3; p. 14, ll. 26-33) for said remote storage device (150 in FIG. 1) specified by a user at said configured multifunction device (100 in FIG. 1). The method also comprising retrieving said user-requested document (120 in FIG. 1) from said configured multifunction device (100 in FIG. 1).

According to claim 21, a multifunction device (100 in FIG. 1; p. 5, ll. 25-30) comprises computer-readable media operatively associated with said multifunction device (100 in FIG. 1) and having computer-readable program code thereon including program code for identifying data (155 in FIG. 1; p. 9, ll. 8-17) operatively associated with a user-specified remote storage device (150 in FIG. 1; p. 6, ll. 13-15), and program code for accessing said data (155 in FIG. 1) operatively associated with said user-specified remote storage device (150 in FIG. 1) from said multifunction device (100 in FIG. 1).

The summary is set forth in several exemplary embodiments that correspond to the independent claims. Discussions about elements and recitations to these claims can be found at least at the cited locations in the specification and drawings.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action rejected claims 1 and 12 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Final Office Action also rejected claims 1, 4-12, and 14-27 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,557,907 to Czyszczewski, et al. (hereinafter referred to as "Czyszczewski"). Appellant requests the Board to review each of these grounds of rejection.

VII. ARGUMENT

Rejection under 35 U.S.C. §101

Claims 1 and 12 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1 and 12

The Final Office Action states that claims 1 and 12 are not statutory "because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts."

Claim 1 positively recites "identifying said user-specified remote storage device . . . establishing a link between said multifunction device and a user-specified remote storage device . . . accessing said electronic document . . . [and] sending said electronic document from said multifunction device. Not only do these recitations include a tangible result (i.e., an electronic document is accessed and sent), but these recitations are also limited to a practical application within the technological arts (i.e., accessing an electronic document and sending it from a multifunction device).

Claim 12 positively recites "identifying a remote storage device . . . [and] retrieving said user-requested document from said configured multifunction device." Not only do these recitations include a tangible result (i.e., a document is retrieved), but these recitations are also limited to a practical application within the technological arts (i.e., retrieving a document from a configured multifunction device).

The Final Office Action also states that "these claims do not indicate use of hardware on which the software runs to perform the steps recited in the body

of the claim. However, claim 1 positively recites "a multifunction device" and claim 12 positively recites "a configured multifunction device." The term "multifunction device" is well understood in the computer consumer products industry as a type of computing device, and therefore is known to have or otherwise be associated with computer-readable media for computer-readable program code. However, if there is any question as to whether the multifunction device includes hardware on which the software runs to perform the recited steps, Appellant's specification explains that multifunction devices are provided with computer-readable media and computer-readable program code. *See, e.g.,* page 6, lines 13-25.

The Final Office Action also states that "the use of a computer has not been indicated" and "the use of a computer is not evident in the claim." The sections of the MPEP that the examiner cited do not require that the term "computer" be recited in order to be considered statutory subject matter. As noted above, multifunction devices are well-known in the industry as a type of computing device.

Accordingly, the Examiner has failed to establish that the invention is directed to non-statutory subject matter.

Rejection under 35 U.S.C. §102(e)

Claims 1, 4-12, and 14-27 stand rejected under 35 U.S.C. §102(e) as being anticipated by Czyszczewki.

It is well settled that invalidity for anticipation requires that a single prior art reference disclose each claim recitation. Every element must be literally present, arranged as in the claim.

Independent Claim 1

Claim 1 positively recites "identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device." The cited references fail to teach or suggest at least these recitations.

The Office Action cites to Czyszczewski at col. 3, lines 11-17, which states:

"The teachings herein also provide an ability to dynamically and bidirectionally integrate remote datastores or databases, and provide access to the information locally or remotely. These teachings also support the exchange of information so that the multifunction device can retrieve information from, and insert information into, remote datastores."

Although this citation discloses the multifunction device accessing remote datastores, there is no teaching of a user-specified remote storage device.

The Office Action also cites to Czyszczewski at col. 9, line 60 to col. 10, line 3, which states:

"The multifunction controller 25 also has the ability to accept downloads of various characteristics of the databases 150, for providing an efficient use of the global network 50. For example, the corporate directory database 185 may generate an index on a periodic basis and download the index to the multifunction controller 25, thereby allowing the multifunction device controller 25 to quickly determine the location of corporate directory information for a particular user. Index generation may be initiated by either a

particular one of the databases 150, or by the multifunction controller 25 itself on a periodic basis."

Although this citation discloses accepting downloads from a remote database 150, there is no teaching of a user-specified remote storage device. To the contrary, Czyszczewski goes on to clarify index generation, query cycles, and other types of database administrative functions, including access by the multifunction controller is controlled by the remote administrator's database, e.g., at col. 10, lines 16-20:

"For example, it may be desirable for the multifunction controller 25 to have access to only a subset of the databases 150 that are provided as part of the global optional services 55. This limited access is controlled by the remote administrator's database 200." [Emphasis added].

Czyszczewski discloses a form of automated database access. Czyszczewski also explains how the user can retrieve a document from a remote datastore using predetermined links to the remote datastores. See, e.g., col. 11, lines 20-21 (providing access to a predetermined corporate directory), and col. 11, lines 1-12 (requiring the user to first upload documents to the multifunction device and then go through a security protocol at the multifunction device to access the documents already uploaded to the multifunction device). However, there is no teaching or suggestion of identifying a user-specified remote storage device based at least in part on a path specified by a user

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 1 is anticipated by Czyszczewski.

Dependent Claims 4 and 7-11

Claims 4 and 7-11 depend from claim 1, which is believed to be allowable. Therefore, claims 4 and 7-11 are also believed to be allowable for at least the same reasons as claim 1.

Dependent Claim 5

Claim 5 depends from claim 1, which is believed to be allowable. Therefore, claim 5 is also believed to be allowable for at least the same reasons as claim 1.

In addition, claim 5 positively recites "combining said document in electronic format with said electronic document from said user-specified remote storage device." The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 10, lines 59-60, which states:

"The multifunction device 10 may also check the website periodically to ensure that it has a current list of documents."

This citation discusses having access to the latest versions of documents to be printed, faxed or e-mailed on demand. However, there is no teaching or suggestion that an electronic document from the user-specified remote storage device is combined with a document converted to electronic format at the multifunction device.

The Office Action also relies on Czyszczewski at Col. 6, lines 53-59, which states:

"Databases A, B, and C (57, 60, and 65, respectively) may respectively store information regarding, for example, user

profiles, user identifications and forms, that is, copies of commonly used documents in electronic format. Servers 70, 73, and 75 may include, for example, a print server 70, a fax server 73 and an e-mail server 75. . . ."

However, there is no disclosure of converting a document to electronic format at the multifunction device and then combining the document with an electronic document from a user-specified remote storage device. The Office Action is reading more into the Czyszczewski reference than is actually disclosed. For at least these reasons, claim 5 is believed to be allowable.

Dependent Claim 6

Claim 6 depends from claim 1, which is believed to be allowable. Therefore, claim 6 is also believed to be allowable for at least the same reasons as claim 1.

In addition, claim 6 positively recites "combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device." The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 10, lines 48-60. This citation discusses having access to the latest versions of documents, to be printed, faxed or e-mailed on demand. However, there is no teaching or suggestion that an electronic document from the user-specified remote storage device is combined with a document converted to electronic format at the multifunction device. For at least these reasons, claim 6 is believed to be allowable.

For at least the foregoing reasons, the Examiner has failed to establish that dependent claims 4-11 are anticipated by Czyszczewski.

Independent Claim 12

Claim 12 positively recites "identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device." Again, the Office Action relies on Czyszczewski at col. 3, lines 11-17. As discussed in detail above for claim 1, these citations do not teach or suggest at least the recitations of claim 12.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 12 is anticipated by Czyszczewski.

Dependent Claims 14 and 17-20

Claims 14 and 17-20 depend from claim 12, which is believed to be allowable. Therefore, claims 14 and 17-20 are also believed to be allowable for at least the same reasons as claim 12 and withdrawal of the rejection of claims 14 and 17-20 is respectfully requested.

Dependent Claim 15

Claim 15 depends from claim 12, which is believed to be allowable. Therefore, claim 15 is also believed to be allowable for at least the same reasons as claim 12.

In addition, claim 15 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

Dependent Claim 16

Claim 16 depends from claim 12, which is believed to be allowable. Therefore, claim 16 is also believed to be allowable for at least the same reasons as claim 12.

In addition, claim 16 is also believed to be allowable for at least the same reasons as discussed above for claim 6.

Independent Claim 21

Claim 21 positively recites "including program code for identifying data operatively associated with a user-specified remote storage device; and program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device" (emphasis added). Czyszczewski fails to teach or suggest at least these recitations.

Again, the Office Action relies on Czyszczewski at col. 9, line 60 to col. 10, line 3. As discussed in detail above for claim 1, these citations do not teach or suggest at least the recitations of claim 12.

Czyszczewski implements a predetermined remote datastore (i.e., "the corporate directory database"). *See, e.g.*, col. 9, lines 38-49 (requiring the user to store documents in the corporate directory database for automatic retrieval by the controller). If the user were allowed to specify a remote storage device there would be no need to first store documents in the corporate directory database before accessing those documents at the multifunction device. *See, e.g.*, col. 10, lines 49-56; col. 11, lines 1-12 and 20-21 (clarifying that the remote datastore is predetermined and not user-specified). Czyszczewski fails to disclose a user-specified remote storage device.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 21 is anticipated by Czyszczewski.

Dependent Claims 22-25 and 27

Claims 22-25 and 27 depend from claim 21, which is believed to be allowable. Therefore, claims 22-25 and 27 are also believed to be allowable for at least the same reasons as claim 21 and withdrawal of the rejection of claims 22-25 and 27 is respectfully requested.

Dependent Claim 26

Claim 26 depends from claim 21, which is believed to be allowable. Therefore, claim 26 is also believed to be allowable for at least the same reasons as claim 21.

In addition, claim 26 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

Conclusion

For the reasons provided herein, Appellant respectfully requests the Board to rule that the rejections of the claims are improper.

Respectfully Submitted,

Dated: 12-16-2005

By: Mark D. Trenner

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VIII. CLAIMS APPENDIX

1. A method for providing access from a multifunction device to an electronic document at a user-specified remote storage device, comprising:

identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device;

establishing a link between said multifunction device and a user-specified remote storage device having said electronic document;

accessing said electronic document at said user-specified remote storage device from said multifunction device over said link established therebetween; and

sending said electronic document from said multifunction device.

2. (canceled).

3. (canceled).

4. The method of claim 1, wherein identifying said user-specified remote storage device is based at least in part on a user profile.

5. The method of claim 1, further comprising:
converting a document to electronic format at said multifunction device;
and

combining said document in electronic format with said electronic document from said user-specified remote storage device.

6. The method of claim 1, further comprising:

combining said accessed data said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device; and

sending said combined electronic documents from said multifunction device to a network destination.

7. The method of claim 1, further comprising accessing an address book operatively associated with said user-specified remote storage device.

8. The method of claim 7, further comprising identifying a network destination for an electronic document generated at said multifunction device based on data from said address book.

9. The method of claim 7, further comprising editing an entry in said address book operatively associated with said user-specified remote storage device from said multifunction device.

10. The method of claim 1, further comprising configuring said multifunction device before identifying said user-specified remote storage device.

11. The method of claim 1, further comprising displaying at least a portion of said electronic document from said user-specified remote storage device at said multifunction device.

12. A method for accessing user-requested data from a configured multifunction device, comprising:

identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device; and

retrieving said user-requested document from said configured multifunction device.

13. (canceled).

14. The method of claim 12, wherein identifying said remote storage device is based at least in part on a user profile.

15. The method of claim 12, further comprising:

converting a document to electronic format at said configured multifunction device; and

combining said document in electronic format with said retrieved user-requested document.

16. The method of claim 12, further comprising:

combining said retrieved user-requested document with an electronic document generated at said configured multifunction device; and

sending said combined electronic document and retrieved user-requested document from said configured multifunction device to a network destination.

17. The method of claim 12, further comprising retrieving user-requested data from an address book operatively associated with said remote storage device.

18. The method of claim 17, further comprising identifying a network destination for an electronic document generated at said configured multifunction device based on said user-requested data retrieved from said address book.

19. The method of claim 17, further comprising editing an entry in said address book operatively associated with said remote storage device from said multifunction device.

20. The method of claim 17, further comprising displaying at least a portion of said data at said multifunction device.

21. A multifunction device comprising:

computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying data operatively associated with a user-specified remote storage device; and

program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device.

22. The multifunction device claim 21, wherein said data is an address book.

23. The multifunction device of claim 22, wherein said computer-readable media comprises:

program code for retrieving an entry from said address book, said entry identifying a network destination;

program code for associating said entry from said address book with an electronic document at said multifunction device; and

program code for sending said electronic document to said network destination identified by said entry from said address book.

24. The multifunction device of claim 21, wherein said data is a document in electronic format.

25. The multifunction device of claim 21, wherein said computer-readable media comprises:

program code for sending a document in electronic format from said multifunction device to a network destination.

26. The multifunction device of claim 21, wherein said computer-readable media further comprises:

program code for combining a document in electronic format with a document image at said multifunction device;

program code for sending said combination of said document in electronic format and said document image from said multifunction device to a network destination.

27. The multifunction device of claim 21, wherein said user-specified remote device is another multifunction device.

IX. EVIDENCE APPENDIX

Not applicable.

X. RELATED PROCEEDINGS APPENDIX

Not applicable.